

REMARKS

Claims 1-35 are pending. Claims 1, 7, 19, 21, and 24 have been amended. Claims 28-35 have been added. No new matter has been introduced. Applicants respectfully request reconsideration of the application.

In the August 27, 2003 Office Action, the Examiner rejected claims 1-27. Claims 1, 2, 5-8, 10-13, 17, and 19-27 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,979,757 to Tracy et al. ("Tracy"). Claims 3, 4, 9, and 14-16 were rejected under 35 U.S.C. §103(a) as being obvious over Tracy in view of U.S. Patent No. 6,129,274 to Suzuki ("Suzuki"). Claim 18 was rejected under 35 U.S.C. §103(a) as being obvious over Tracy in view of the Examiner's Official Notice. These rejections are respectfully traversed.

Embodiments of the present invention are directed to a method for a handheld recommendation assistant. A handheld device reads product information of a product from a product tag. Consumer information is retrieved through a connection to a consumer information storage device. The consumer information is associated with the product and is retrieved based at least in part on the product information. The consumer information includes information about the product. Personal information of a user is acquired relevant to at least one aspect of the product. A product recommendation is generated related to the product based at least in part on the personal information and the consumer information. The product recommendation is generated by a recommendation processor housed within the handheld recommendation assistant.

In the August 27, 2003 Final Office Action, the Examiner rejected claims 1, 2, 5-

8, 10-13, 17, and 19-27 under 35 U.S.C. §102(b) as being anticipated by Tracy. The Examiner stated that Tracy discloses a system/method of a handheld recommendation assistant 70 comprising a barcode scanner reading product information from a product tag, retrieving consumer information through a connection to a consumer information storage device, acquiring personal information of a user, and generating a product recommendation list. The Examiner further stated that “the product recommendation is determined by remote server, which is a central host”.

In response to applicants' May 9, 2003 Amendment, the Examiner also stated the following:

“it is the Examiner opinion that the Tracy patent still teaches the subject matter claimed in the amended claims. The shopping assistant of Tracy clearly suggest ‘recommendation’ functionality (col. 9, lines 55+), wherein the customer can be alerted based on selected criteria (i.e., cholesterol, calories, fat content, etc.) of a product.

Although Applicant's explanations distinguishing the claimed invention from Tracy/Suzuki that ‘specifies that the handheld recommendation assistant itself makes a recommendation to the user, rather than a central host’ (page 9, 1st paragraph), it is the Examiner's position that the Tracy patent teaches that the device makes the recommendation itself.”

Claims 3, 4, 9, and 14-16 were rejected under 35 U.S.C. §103(a) as being obvious over Tracy in view of Suzuki. The Examiner stated that Tracy “fails to teach or fairly suggest that the personal information include[es] tailoring measurements, a color preference.” However, the Examiner further stated that Suzuki teaches the above limitation and that it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Tracy and Suzuki, in the direction of claims 3, 4, 9, and 14-16.

Claim 18 was rejected under 35 U.S.C. §103(a) as being obvious by Tracy in view of Official Notice. The Examiner stated that Tracy “fails to teach or fairly suggest

the step of storing the product information in a machine readable form in the product tag; and attaching the product tag containing the machine readable product information to the product.” The Examiner took Official Notice that such step would have been obvious to a person of ordinary skill in the art at the time of the invention.

Independent claim 1, as amended, recites (with emphasis added):

1. **A method for a handheld recommendation assistant**, said method comprising:
reading, by a handheld device, product information of a product from a product tag;
retrieving consumer information through a connection to a consumer information storage device, said consumer information being associated with said product and being retrieved based at least in part on said product information, said consumer information including information about said product;
acquiring personal information of a user relevant to at least one aspect of said product; and
generating a product recommendation related to said product based at least in part on said personal information and said consumer information, the product recommendation being generated by a recommendation processor housed within the handheld recommendation assistant.

Tracy discloses a method and system for presenting item information to a shopper using a portable data terminal. The shopper carries the portable data terminal around, as shown in FIG. 4. The portable data terminal is used to collect data from a coded label for a product. The coded label can include uniform resource locators (“URLs”) used to reference sites on the world wide web. [Col. 2, lines 42-45.] The “URLs are used by the portable terminal to retrieve data files including items such as prices, nutritional data, coupon availability, promotions, marketing data and general interest data from various local and remote addressed available over a wireless communication network.” [Col. 2, lines 45-49.] The shopper retrieves the portable terminal from a dispenser unit 230 after entering the store, as shown in FIG. 6. [Col. 7, lines 4-9.] The portable terminal communicates data with a central host 14 located

locally. “[T]he **central host** retrieves data, processes information and retransmits data to portable terminals.” [Emphasis added, col. 6, lines 1-3.] “[T]he central host 14 can also retrieve data from external sources such as IP addressable servers 40 and 50 through a wide area communication network.” [Col. 6, lines 5-7.] Each shopper “who uses the system has an associated file stored on the central host including a customer preference list.” [Col. 9, lines 6-8.] The system can also display price and nutritional data for products. [Col. 11, lines 45-46.] The central host can also deliver to the user’s email address a complete listing of available items in the store based on the user’s previously purchased items. [Col. 14, lines 49-54.]

In the August 27, 2003 Office Action, the Examiner stated that col. 9, lines 55+ of Tracy “clearly suggest [a] ‘recommendation’ functionality, wherein the customer can be alerted based on selected criteria (i.e., cholesterol, calories, fat contents, etc.) of a product”. Applicants respectfully disagree with the Examiner’s contentions regarding the disclosure of Tracy. Specifically, applicants have reviewed Tracy, beginning at col. 9, lines 55+, as set forth by the Examiner, and have found no disclosure of the product recommendation being generated by a handheld recommendation assistant. Instead, the recommendations are made at the central host, and the portable terminal 100 is merely a “dumb” device. Moreover, Tracy teaches away from the portable terminal 100 performing such recommendations. Specifically, Tracy teaches the following (with emphasis added) at col. 3, lines 49-54:

“Data collected with the portable terminal is communicated to a central host. In a preferred embodiment, *the central host performs most of the computing functions, thereby reducing the computational memory and power requirements of the portable terminals communicating with the system.*”

Furthermore, applicants note that independent claim 1, as amended, now

specifies that the recommendation is generated by a *recommendation processor housed within the handheld terminal*. Applicants respectfully submit that Tracy does not disclose, teach or suggest such recommendation being generated by a recommendation processor housed within a handheld recommendation assistant.

Suzuki does not make up for the deficiencies of Tracy. Suzuki discloses a system and method for updating a shopping transaction history using an electronic personal digital shopping assistant. The digital assistant includes a data storage partition which stores “customer specific demographic information, including information related to that customer's identity and status, and also ... information relating to a customer's brand preferences and personal preference metrics, such as clothing size, colors, patterns, style and the like.” [Col. 4, lines 19-24.]

However, Suzuki does not disclose, teach, or suggest, alone or in combination with Tracy and/or the Examiner's Official Notice, a method for a handheld recommendation assistant, the method comprising reading, by a handheld device, product information of a product from a product tag, and generating a product recommendation related to said product based at least in part on said personal information and said consumer information, where *the product recommendation is generated by a recommendation processor housed within the handheld recommendation assistant*. As set forth above, Tracy, merely discloses a dumb portable terminal which reads a product ID, and then transmits the ID to the central host 14, which processes the product ID, acquires any additional information concerning the product, and provides a price and nutritional data for the product to the user. Accordingly, Tracy teaches that the *central host 14* acquires and determines the price

and nutritional data.

Independent claim 1, as amended, *specifies that a recommendation processor housed within the handheld recommendation assistant itself makes a recommendation to the user, rather than a central host.* This is a significant distinction, because the entire disclosure of Tracy is directed toward an embodiment involving use of a portable terminal which the user only uses when physically inside the store, and which is only for use at that one store. Moreover, the portable terminal could only be used at that one particular store because all of the processing is done by the central host for the store. The embodiment specified according to independent claim 1, as amended, however, could be used in any number of different stores, because the processing is performed by the handheld recommendation assistant itself. Accordingly, independent claim 1, as amended, distinguishes over Tracy, alone or in combination with Suzuki and/or Official Notice.

Claims 2-18, 26, and 27 all directly depend from independent claim 1, as amended, and therefore also distinguish over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice, for reasons similar to those set forth above with respect to independent claim 1, as amended

Moreover, as applicants discussed in the May 9, 2003 Amendment, claim 3 further distinguishes over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice. Claim 3 recites "[t]he method according to claim 1, wherein said product information includes a list of the ingredients of a product." Tracy discloses display of nutritional information, but it does not disclose, teach, or suggest, acquisition of a list of the ingredients of a product. Acquiring the list of ingredients is useful for a

shopper to help prevent a product which, for example, contains ingredients to which the customer is allergic. Accordingly, the display of nutritional information is far different than the acquisition of ingredients. Neither Suzuki nor the Examiner's Official Notice makes up for the deficiencies of Tracy. Therefore, claim 3 further distinguishes over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice.

Claim 9 also further distinguishes over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice as applicants discussed in the May 9, 2003 Amendment. Claim 9 recites (with emphasis added): "[t]he method according to claim 1, wherein said consumer information includes *tailored measurements of a clothing product*." Tailored measurements can be very useful to the shopper because different clothing manufacturers often make different sized clothing for the same sized category (e.g., "medium size"). Because the user may wear a medium-sized shirt for some manufacturers, and a small-sized shirt for other manufacturers, the tailored measurements can be useful in making a recommendation to the customer. Providing such tailored measurements is not disclosed, taught, or suggested by Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice. Suzuki discloses storing a customer's size preference, but does not teach storing anything as specific as "tailored measurements". Therefore, claim 9 further distinguishes over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice.

Independent claims 19, 21, and 24, each as amended, each contain limitations similar to those of independent claim 1, as amended, and therefore also distinguish over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice for reasons similar to those set forth above with respect to independent claim 1, as

amended. Claim 20 directly depends from independent claim 19, and therefore also distinguishes over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice for the same reasons as those set forth above with respect to independent claim 19, as amended. Claims 22 and 23 directly depend from independent claim 21, and therefore also distinguish over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice for the same reasons as those set forth above with respect to independent claim 21, as amended. Claim 25 directly depends from independent claim 24, and therefore also distinguishes over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice for the same reasons as those set forth above with respect to independent claim 24, as amended.

Accordingly, for the reasons set forth above, applicants respectfully submit that the rejection of claims (a) 1, 2, 5-8, 10-13, 17, and 19-25 under 35 U.S.C. §102(b), and (b) 3, 4, 9, 14-16, and 18 under 35 U.S.C. §103(a) should be withdrawn.

New claims 28-35 further distinguish over Tracy, alone or in combination with Suzuki and/or Official Notice. New claim 28 recites (with emphasis added):

28. A method for a handheld recommendation assistant, said method comprising:
reading, by a handheld device, product information of a product from a product tag;
retrieving consumer information from a consumer information database housed within the handheld recommendation assistant, said consumer information being associated with said product and being retrieved based at least in part on said product information, said consumer information including information about said product;
acquiring personal information of a user relevant to at least one aspect of said product; and
generating a product recommendation related to said product based at least in part on said personal information and said consumer information, the product recommendation being generated by the handheld recommendation assistant.

None of Tracy, Suzuki, or the Examiner's Official Notice disclose, teach, or suggest use of a consumer information database which is housed within a recommendation assistant. The Examiner even admitted as such in the August 27, 2003 Office Action. Specifically, the Examiner stated:

"In terms of where the database resides in making recommendations, Tracy may not explicitly suggest that the database is loaded in the hand-held terminal. Examiner also notes, upon careful reading of claim 1, that the claim 1 of instant application does not explicitly suggest such feature – database is resident on the handheld device as opposed to a central host"

Therefore, applicants respectfully submit that new independent claim 28 distinguishes over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice. New independent claims 30, 32, and 34 each contain limitations similar to those of new independent claim 28, and therefore also distinguish over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice for reasons similar to those set forth above with respect to new independent claim 28.

New claim 29 also further distinguishes over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice. New claim 29 recites (with emphasis added): "[T]he method according to claim 28, wherein the product recommendation is generated by a recommendation processor housed within the handheld recommendation assistant." As discussed above with respect to independent claim 1, as amended, Tracy does not, alone or in combination with Suzuki and/or the Examiner's Official Notice, disclose, teach or suggest such product recommendation being generated by a recommendation processor housed within a handheld recommendation assistant. Therefore, applicants respectfully submit that new independent claim 29 distinguishes over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice. New independent claims 31, 33, and 35 each

contain limitations similar to those of new independent claim 29, and therefore also distinguish over Tracy, alone or in combination with Suzuki and/or the Examiner's Official Notice for reasons similar to those set forth above with respect to new independent claim 29.

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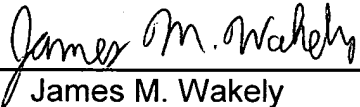
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Applicants believe that the foregoing amendments place the application in condition for allowance, and a favorable action is respectfully requested. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call either of the undersigned attorneys at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in condition for allowance should the Examiner believe that such a telephone conference would advance prosecution of the application.

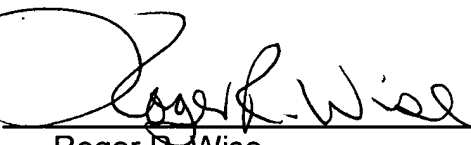
Respectfully submitted,

PILLSBURY WINTHROP LLP

Date: November 25, 2003

By: 
James M. Wakely
Registration No. 48,597
Attorney for Applicants

Date: November 25, 2003

By: 
Roger R. Wise
Registration No. 31,204
Attorney For Applicants

725 South Figueroa Street, Suite 2800
Los Angeles, CA 90017-5406
Telephone: (213) 488-7100
Facsimile: (213) 629-1033